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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,383	11/13/2000	Paul Jackson	37965-0006	5085

30147 7590 01/18/2002

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EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT PAPER NUMBER

1626

DATE MAILED: 01/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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10

DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire months(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-30 are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-30 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

09/709,383

## DETAILED ACTION

Claims 1-30 are pending in the application.

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, drawn to products not embraced by the products of Groups II-XIV defined below.
- II. Claims 4 and 5, drawn to products of core structure (I) wherein X and X<sub>1</sub> are each CR<sub>2</sub>R<sub>3</sub>, classified in class 548, subclass 530+.
- III. Claims 4 and 5, drawn to products of core structure (I) wherein X is CR<sub>2</sub>R<sub>3</sub> and X<sub>1</sub> is O or X is O and X<sub>1</sub> is CR<sub>2</sub>R<sub>3</sub>, classified in class 548, subclass 215+.
- IV. Claims 4 and 5, drawn to products of core structure (I) wherein X is CR<sub>2</sub>R<sub>3</sub> and X<sub>1</sub> is S or X is S and X<sub>1</sub> is CR<sub>2</sub>R<sub>3</sub>, classified in class 548, subclass 146+.

- V. Claims 4 and 5, drawn to products of core structure (I)  
wherein X is CR2R3 and X<sub>1</sub> is N or X is N and X<sub>1</sub> is CR2R3,  
classified in class 548, subclass 300.1+.
- VI. Claims 6 and 7, drawn to products of core structure (II)  
wherein X is CR2R3, classified in class 546, subclass 184+.
- VII. Claims 6 and 7, drawn to products of core structure (II)  
wherein X is O, classified in class 544, subclass 106+.
- VIII. Claims 6 and 7, drawn to products of core structure (II)  
wherein X is S, classified in class 544, subclass 3+.
- IX. Claims 6 and 7, drawn to products of core structure (II)  
wherein X is NR4, classified in class 544, subclass 336+.
- X. Claims 8 and 9, drawn to products of core structure (III),  
classified in classes 562, 564, etc.
- XI. Claims 10 and 11, drawn to products of core structure (IV)  
wherein X is CR2R3 and X<sub>1</sub> is CR2R3, classified in class 562.

XII. Claims 10 and 11, drawn to products of core structure (IV)

wherein X is CR2R3 and X<sub>1</sub> is O or X is O and X<sub>1</sub> is CR2R3,  
classified in class 549, subclass 429+.

XIII. Claims 10 and 11, drawn to products of core structure (IV)

wherein X is CR2R3 and X<sub>1</sub> is S or X is S and X<sub>1</sub> is CR2R3,  
classified in class 549, subclass 29+.

XIV. Claims 10 and 11, drawn to products of core structure (IV)

wherein X is CR2R3 and X<sub>1</sub> is NR4 or X is NR4 and X<sub>1</sub> is  
CR2R3, classified in class 548, subclass 530+.

XV. Claims 12-14 and 21-28, drawn to methods of using products

of core structure (I) wherein X and X<sub>1</sub> are each CR2R3,  
classified in class 514, subclass 408+.

XVI. Claims 12-14 and 21-28, drawn to methods of using products

of core structure (I) wherein X is CR2R3 and X<sub>1</sub> is O or X is  
O and X<sub>1</sub> is CR2R3, classified in class 514, subclass 374+.

XVII. Claims 12-14 and 21-28, drawn to methods of using

products of core structure (I) wherein X is CR2R3 and X<sub>1</sub> is S

or X is S and X<sub>1</sub> is CR2R3, classified in class 514, subclass 365+.

XVIII. Claims 12-14 and 21-28, drawn to methods of using

C N  
products of core structure (I) wherein X is CR2R3 and X<sub>1</sub> is N  
or X is N and X<sub>1</sub> is CR2R3, classified in class 514, subclass 396+.

XIX. Claims 15, 16 and 21-28, drawn to methods of using

products of core structure (II) wherein X is CR2R3, classified in class 514, subclass 315+.

XX. Claims 15, 16 and 21-28, drawn to methods of using

products of core structure (II) wherein X is O, classified in class 514, subclass 231.2+.

XXI. Claims 15, 16 and 21-28, drawn to methods of using

products of core structure (II) wherein X is S, classified in class 514, subclass 227.5+.

XXII. Claims 15, 16 and 21-28, drawn to methods of using products of core structure (II) wherein X is NR<sub>4</sub>, classified in class 514, subclass 252.1+.

XXIII. Claims 17, 18 and 21-28, drawn to methods of using products of core structure (III), classified in class 514, subclass 613+.

XXIV. Claims 19-28, drawn to methods of using products of core structure (IV) wherein X is CR<sub>2</sub>R<sub>3</sub> and X<sub>1</sub> is CR<sub>2</sub>R<sub>3</sub>, classified in class 514, subclass 553+.

XXV. Claims 19-28, drawn to methods of using products of core structure (IV) wherein X is CR<sub>2</sub>R<sub>3</sub> and X<sub>1</sub> is O or X is O and X<sub>1</sub> is CR<sub>2</sub>R<sub>3</sub>, classified in class 514, subclass 461+.

XXVI. Claims 19-28, drawn to methods of using products of core structure (IV) wherein X is CR<sub>2</sub>R<sub>3</sub> and X<sub>1</sub> is S or X is S and X<sub>1</sub> is CR<sub>2</sub>R<sub>3</sub>, classified in class 514, subclass 438+.

XXVII. Claims 19-28, drawn to methods of using products of core structure (IV) wherein X is CR<sub>2</sub>R<sub>3</sub> and X<sub>1</sub> is NR<sub>4</sub> or X is NR<sub>4</sub> and X<sub>1</sub> is CR<sub>2</sub>R<sub>3</sub>, classified in class 514, subclass 423+.

→ XXVIII. Claims 21, 22 and 24-27, drawn to methods of using an inhibitor of dipeptidyl peptidase IV not embraced by Groups XV-XXVII, classified in class 514.

XXIX. Claim 29, drawn to methods of using products, classified in class 514, subclass 365+.

XXX. Claim 30, drawn to methods of using products, classified in class 514, subclass 408+.

The inventions are distinct, each from the other because of the following reasons: the compounds of Groups I-XIV differ materially in structure and element so much so as to be patentably distinct. In addition, a reference that anticipates one group may not even render obvious the other. The inventions of Groups I-XIV and Groups XV-XXX are related as product and process of use. The inventions can be shown



to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process for using the product can be practiced with another materially different product such as the product of Group II or the product of Group III, etc.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and the search required for Group II, for example, is not required for Group XXVI, restriction for examination purposes as indicated is proper.

**Additionally, Applicants are also required to elect a single disclosed species from whichever group is elected.**

The inventions of Groups I and XXVIII do not specify a particular product in the claims which fall under these groups. If either of these groups is elected, a generic concept, which would embrace the elected species, will be identified by the Examiner for examination.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to

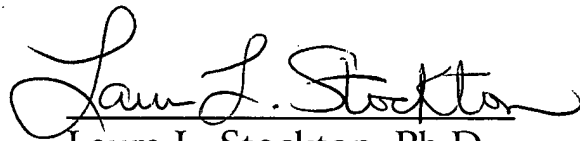
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Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235, 308-0196 or 305-3290.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556, 308-4242, 305-1935 or 308-2742.

  
Laura L. Stockton, Ph.D.  
Patent Examiner  
Art Unit 1626, Group 1620  
Technology Center 1600

January 16, 2002